

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael S. Beck &
Kevin L. Conrad

Serial No.: 10/784,341

Filed: February 23, 2004

For: System And Method for Dynamically
Controlling an Attitude Of An Articulated
Vehicle

Confirmation No.: 2359

Group Art Unit: 3661

Examiner: Nguyen, Cuong H.

Attorney Docket: 2063.007400/JAP
CUSTOMER NO. 23,720

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the “final” rejection in the above-identified application. No amendments are being filed with this request. This request is, however, being filed concurrently with a Notice of Appeal. The review is requested for the reason(s) stated on the attached sheet(s). It is believed no fee is due; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason, the Director is authorized to deduct said fees from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/2063.007400.

I. STATUS OF THE CLAIMS

Claims 1-53 are pending in the case. The Office rejected claims 1-19. Claims 1-4, 9-10, 14-15, and 17-18 were rejected as anticipated under 35 U.S.C. §102(e) by U.S. Letters Patent 6,010,139 (“Heyring *et al.*”). It also rejected claims 5-9, 11-13, 15-16, and 19 as obvious under 35 U.S.C. §103(a) over Heyring *et al.* in combinations of U.S. Publication No. 2003/0001734 (“Schofield”);¹ U.S. Patent No. 6,267,196 (“Wilcox”); U.S. Patent No. 4,313,511 (“Soo Hoo”);

¹ Applicants do not concede the status of Schofield as “prior art”. Schofield does not actually qualify as prior art under any provision of 35 U.S.C. §102. The Office may nevertheless cite Schofield under the legal fiction that it evidences what was “known by others” under 35 U.S.C. §102(a) on the assumption that Applicants’ data of invention is their date of filing. Applicants reserve the right to “swear behind” Schofield at a future date should they choose to do so. See M.P.E.P. §2132.91.

and U.S. Patent No. 4,243,278 (“Horan”). The current status of claims 20-53 is ambiguous.² The Office has not officially withdrawn these claims, but has not examined them since the Office Action dated October 24, 2007. For purposes of prosecution, Applicants have considered those claims to have been implicitly withdrawn. Each of the rejections is currently on appeal.

IV. THE ERRORS IN THE REJECTIONS

Applicants request review of the merits for each ground of rejection and present the following arguments specifying clear errors in the Office’s rejections or the Office’s omission of one or more essential elements needed for a *prima facie* rejection.

A. CLAIMS 1-4, 9-10, 14-15, AND 17-18 ARE NOVEL OVER HEYRING ET AL

The Office rejected claims 1-4, 9-10, 14-15, and 17-18 as anticipated under 35 U.S.C. §102(e) by U.S. Letters Patent 6,010,139 (“Heyring *et al.*”). An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990). Of these claims, only claim 1 is independent, and it recites “determining at least one dynamic property of the vehicle”:

1. A method of controlling stability of a vehicle having an articulated suspension, comprising:
determining at least one dynamic property of the vehicle;
and
manipulating the articulated suspension based on the at least one dynamic property to affect the stability of the vehicle.

Claims 2-4, 9-10, 14-15, and 17-18 incorporate this limitation by operation of law. 35 U.S.C. §112, ¶4.

Heyring *et al.* fails to disclose this limitation. More particularly, the suspension system Heyring *et al.* may react to conditions such as a change in a dynamic property, but it does not determine what that changing condition is. This is most evident from the passage found at col. 5, lines 17-31 thereof. As indicated in that passage, the suspension system of Heyring *et al.* simply

² Applicants file concurrently herewith a petition seeking lift or modify the restriction, or at least to eliminate the ambiguity of these claims’ status.

maintains an even balance of pressure and does not in any way care from where the imbalance originates. The actual changing condition that is involved is immaterial. Furthermore, the suspension system may react to changes in pressure resulting from conditions other than changes in a dynamic property.

The Office alleges that col. 2 line 58 to col. 3, line 16 of Heyring *et al.* teaches all the limitations of the claim, including the subject one. However, in this passage, there is no discussion of “determining at least one dynamic property of the vehicle”—this passage merely discusses how to mitigate adverse performance in pitch and roll. Thus, the rejections are predicated on a misconstruction of Heyring *et al.*

Furthermore, with respect to the rejection of claim 14, the Office relies on a misconstruction of Applicants’ “Appeal Brief” filed earlier in this prosecution. The Office takes a passage out of its context and then misconstrues it in a manner supporting a rejection it would like to make. More particularly, in Applicants’ Appeal Brief, at p. 12, lines 7-16, stated:

However, Applicants respectfully submit that sufficient disclosure has been provided that those skilled in the art will readily be able to ascertain how to “determine a damping scenario”. Applicants provide a great deal of information about how the articulation of the suspension system can be dampened as a part of the articulation. (¶[0064]- ¶[0078]) Applicants also provide a great deal of information as to how the suspension may be articulated as the vehicle crosses both smooth and rough terrain. (¶[0097]- ¶[0113]) Since damping is a part of articulation and both damping and articulation have been thoroughly disclosed, those of ordinary skill in the art will certainly be able to tell what it means to “determine a damping scenario”. Indeed, two specific examples are actually provided in **FIG. 11** and **FIG. 12** and are discussed in ¶[0097]- ¶[0113].

Applicants were therefore explaining that, *in their disclosed embodiment*, damping is a part of articulation and that both are adequately disclosed. However, the Office erroneously warps this into a generalized admission that damping is inherently a part of articulation. Applicants said no such thing and such a construction is clearly erroneous when the statement is considered in its context. Consequently, the rejections are also predicated on a misconstruction of Applicants’ prior arguments.

Thus, Heyring *et al.* fails to teach “determining at least one dynamic property of the vehicle”. As is established above, Heyring *et al.* only reacts to an adverse condition—which

may or may not be caused by a change in dynamic property—and takes no note of what causes it. Heyring *et al.* therefore fails to anticipate any of claims 1-4, 9-10, 14-15, and 17-18. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

**B. ALL REMAINING CLAIMS ARE UNOBVIOUS
OVER THE ART OF RECORD**

The remaining rejections are all for obviousness, and all of them rely on U.S. Letters Patent 6,010,139 (“Heyring *et al.*”) as the primary reference. Each of these rejections relies upon Heyring *et al.* to teach all the limitations of independent claim 1—*i.e.*, to anticipate claim 1. As is established above, Heyring *et al.* fails to do so. Heyring *et al.* fails to teach or suggest “determining at least one dynamic property of the vehicle” as is recited in claim 1. Claims 5-9, 11-13, 15-16, and 19, incorporate this limitation by operation of law. 35 U.S.C. §112, ¶4. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 706.02(j); *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Accordingly, the art of record fails to render obvious any claim in the case because it fails to teach or suggest all the limitations of the claims.

**C. THE OFFICE’S HAS FAILED TO REBUT
THIS EVIDENCE & ARGUMENT**

All of the substantive rejections rely upon the propriety of the anticipation rejections of the independent claims 1 and 14. However, the Office never properly established *prima facie* anticipation of either claim 1 or claim 14 by Heyring *et al.* The Office has not provided a reasonably viable construction of Heyring *et al.* that teaches all the limitations of claims 1 and 14. It is true that the Office put forth a construction of Heyring *et al.*, but Applicants showed that:

- (1) it was contrary to the disclosure of Heyring *et al.* at col. 5, lines 17-31;
- (2) relies on a misconstruction of Heyring *et al.* at col. 2 line 58 to col. 3, line 16; and
- (3) relies on an alleged admission that never was.

(“Response to Office Action Dated March, 31, 2008, pp. 12-15) Thus, it cannot be said to be a construction that “would reasonably allow the conclusion the examiner seeks” or one that “compels such a conclusion if the applicant produces no evidence or argument to rebut it”. *In re Spada*, 15 U.S.P.Q.2d (BNA) 1655, 1657 (Fed. Cir. 1990).

But even if it can be said that the Office's construction constitutes a *prima facie* anticipation, Applicants have clearly produced "evidence or argument to rebut it" as outlined immediately above. The Office's response to that argument falls well short of the mark:

The examiner respectfully maintains his position although applicants argue about distinguish features in the specification since applicants' broad claims read on existing cited references.

(Office Action dated December 2, 2008, "Detailed Action", p. 2, ¶3) And that is the Office's complete response to Applicants' arguments and evidence. Thus, it is apparent from this language that the Office did not even consider Applicants' argument and evidence and merely reasserted its original conclusion. This is clearly contrary to law, which requires "the decision is made on the entirety of the record." *Spada*, 15 U.S.P.Q.2d (BNA) at 1657.

IV. CONCLUDING REMARKS

Applicants respectfully submit that all claims are in condition for allowance. This includes the independent linking claims, meaning the unelected groups must be rejoined and allowed.

The Examiner is invited to contact the undersigned attorney at (713) 934-4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

Date: March 2, 2009

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